

REMARKS

This responds to the Office Action mailed on June 4, 2007.

Claims 1 and 11 are currently amended. Claims 1, 3-16, 18-22 and 24-26 remain pending in this application.

§102 Rejection of the Claims

Claims 1, 4, 16 and 19-21 were rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Bush (U.S. Patent No. 5,755,762, herein “Bush”).

Claims 1 and 16

Claims 1 and 11 have been amended to correct typographic errors.

Applicant respectfully traverses the rejection of claims 1 and 16 and submits that the Office Action does not set forth a proper *prima facie* case of anticipation or obviousness because Bush does not provide the claimed subject matter. For example, Applicant is unable to find in Bush, among other things, a teaching or suggestion of expanded-matrix ultra-high molecular weight polyethylene macromolecule (eUHMWPE) that has an average molecular weight in a range from about 100,000 to about 5,000,000, as recited in independent claims 1 and 16.

The Office Action states, in paragraph 6:

Bush discloses that the porous tubular covering may be made of various materials, including polyethylene (see col. 6, lines 1-13, especially line 5). Examiner considers this polyethylene to be the claimed “expanded ultra-high molecular weight polyethylene macromolecule” since the material of Bush is characterized by pore sizes suitable to allow penetration of bodily fluids but small enough such that fibrous tissue ingrowth is reduced (see col. 6, lines 13-22).

This assertion is respectfully traversed. Bush states, in portions cited in the Office Action (col. 6, lines 1-9):

Porous tubular covering 10 may be made of a fluoropolymer, polyester, polyurethane, cellulose acetate, mixed esters of cellulose, acrylic copolymer on nylon support, polyvinyl difluoride, polysulfone, polypropylene, cellulose nitrate, polycarbonate, nylon, and polyethylene. Preferably, the covering material is a fluoropolymer such as PTFE, FEP, or PFA, and most preferably, PTFE. Covering 10 may be a composite of two or more materials, such as a laminate of acrylic copolymer on a nylon support.

Because polyethylene is not described as a preferred material, and the covering 10 “may be a composite of two or more materials”, the cited portions of Bush do not provide that polyethylene is necessarily a material having the characteristics as alleged in the Office Action. Additionally, the Examiner does not set forth a reason how the alleged pore sizes of Bush’s material lead to the conclusion that its polyethylene is eUHMWPE. Therefore, it is believed that Bush does not provide the eUHMWPE as recited in claims 1 and 16.

Regarding the molecular weight, as recited in claims 1 and 16, the Office Action states, in paragraph 7:

Examiner interprets the polyethylene to inherently have an average molecular weight of 100,000 to 5,000,000 since polyethylene, such as linear low density polyethylene has a molecular weight in the 10⁵ range and UHMWPE in the 10⁶ range ...

This statement is respectfully traversed as an improper and unsupported assertion of inherency. Applicant is unable to find in Bush any teaching or suggestion that the polyethylene is a liner low density polyethylene or UHMWPE, and the Office Action does not provide any extrinsic evidence showing that polyethylene as disclosed in Bush must be such a polyethylene. Applicant respectfully requests a clarification on how the teachings of Bush and/or extrinsic evidence support the assertion of inherency, or withdrawal of the assertion of inherency.

The Office Action further states, in paragraph 8:

In the alternative, it would have been obvious for one or [sic] ordinary skill in the art at the time the invention was made to modify the system with UHMWPE with average molecular weight from 100,000 – 5,000,000 since it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

This statement is respectfully traversed as a form of improper use of official notice. It is believed that choosing the eUHMWPE is not merely “discovering the optimum value”. It is also believed that choosing molecular weight relates to choosing a type of material rather than merely “discovering the optimum value” of the material. Thus, pursuant to M.P.E.P. § 2144.03, Applicant respectfully requests a reference or an affidavit of personal knowledge by the Examiner showing that choosing the eUHMWPE having an average molecular weight in a range from about 100,000 to about 5,000,000 is merely a matter of “discovering the optimum value”, or withdrawal of the obviousness rejection.

Additionally, by stating “[p]referably, the covering material is a fluoropolymer such as PTFE, FEP, or PFA, and most preferably, PTFE” (col. 6, lines 6-7), Bush in fact teaches away from actually using polyethylene as its covering material.

Applicant respectfully requests reconsideration and allowance of claims 1 and 16.

Claims 4 and 19-21

Claim 4 is dependent on claim 1. Claims 19-21 are dependent on claim 16. Claims 1 and 16 are believed to be patentable for at least the reasons set forth above. Therefore, the discussion above for claims 1 and 16 are incorporated herein to support the patentability of claims 4 and 19-21.

Applicant respectfully requests reconsideration and allowance of claims 4, and 19-21.

§103 Rejection of the Claims Using Soukup and Bush

Claims 1, 3-14, 16 and 18-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Soukup et al. (U.S. Patent No. 6,704,604, herein “Soukup”) in view of Bush.

Claims 1 and 16

Claims 1 and 11 have been amended to correct typographic errors.

Applicant respectfully traverses the rejection of claims 1 and 16 and submits that the Office Action does not set forth a proper *prima facie* case of obviousness because Soukup and Bush, individually or in combination, do not provide the claimed subject matter. For example, Applicant is unable to find in Soukup and Bush, individually or in combination, among other things, expanded-matrix ultra-high molecular weight polyethylene macromolecule (eUHMWPE) that has an average molecular weight in a range from about 100,000 to about 5,000,000, as recited in independent claims 1 and 16.

The rejection relies on Bush to provide the eUHMWPE as recited in claims 1 and 16. Therefore, the discussion above supporting the patentability of claims 1 and 16 over Bush is incorporated herein. As discussed above, it is believed that Bush does not provide the claimed eUHMWPE that has an average molecular weight in a range from about 100,000 to about 5,000,000.

Additionally, by stating that PTFE is the most preferable covering material, Bush teaches away from the proposed modification of Soukup's covering with Bush's polyethylene. The Office Action states, in paragraph 14, that "Soukup et al. discloses that the porous covering is constructed from porous PTFE, and thus fails to teach that the porous covering may include 'expanded ultra-high molecular weight polyethylene macromolecule.'" However, Bush states (col. 6, lines 6-7): "Preferably, the covering material is a fluoropolymer such as PTFE, FEP, or PFA, and most preferably, PTFE." Because Soukup uses PTFE, the most preferable material according to Bush, for the covering, Bush in fact teaches away from using another material and hence the proposed combination of references.

Applicant respectfully requests reconsideration and allowance of claims 1 and 16.

Claims 3-14 and 18-21

Claims 3-14 are dependent on claim 1. Claims 18-21 are dependent on claim 16.

Claims 1 and 16 are believed to be patentable for at least the reasons set forth above.

Therefore, the discussion above for claims 1 and 16 are incorporated herein to support the patentability of claims 3-14 and 18-21.

Applicant respectfully requests reconsideration and allowance of claims 3-14 and 18-21.

§103 Rejection of the Claims Using Soukup, Bush, and Czura

Claims 15, 22 and 24-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Soukup et al. in view of Bush as applied above, and further in view of Czura et al. (U.S. Patent No. 5,562,715, herein "Czura").

Claim 15

Claim 15 is dependent on claim 1, which believed to be patentable for at least the reasons set forth above. It is believed that the addition of Czura does not remedy the deficiency of Soukup and Bush as discussed above for claim 1. Therefore, the discussion above for claim 1 is incorporated herein to support the patentability of claim 15.

Applicant respectfully requests reconsideration and allowance of claim 15.

Claim 22

Applicant respectfully traverses the rejection of claim 22 and submits that the Office Action does not set forth a proper *prima facie* case of obviousness because Soukup, Bush, and Czura, individually or in combination, do not provide the claimed subject matter. For example, Applicant is unable to find in Soukup, Bush, and Czura, individually or in combination, among other things, expanded-matrix ultra-high molecular weight polyethylene macromolecule (eUHMWPE) that has an average molecular weight in a range from about 100,000 to about 5,000,000, as recited in independent claim 22.

Because the rejection applies the proposed combination of Soukup and Bush, the discussion above supporting the patentability of claims 1 and 16 over Soukup and Bush are incorporated herein to support the patentability of claim 22. In summary, as discussed above, it is believed that Bush does not provide the claimed eUHMWPE that has an average molecular weight in a range from about 100,000 to about 5,000,000, and in fact teaches away from the proposed modification of Soukup's covering with polyethylene. It is believed that the addition of Czura does not remedy to deficiency of Soukup and Bush as discussed above for claims 1 and 16.

Applicant respectfully requests reconsideration and allowance of claim 22.

Claims 24-26

Claims 24-26 are dependent on claim 22, which believed to be patentable for at least the reasons set forth above. Therefore, the discussion above for claim 22 is incorporated herein to support the patentability of claims 24-26.

Applicant respectfully requests reconsideration and allowance of claims 24-26.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE

Serial Number: 10/662,129

Filing Date: September 12, 2003

Title: EXPANDED ULTRA-HIGH MOLECULAR WEIGHT POLYETHYLENE IN AN ELECTRICAL MEDICAL DEVICE

Page 12

Dkt: 279.445US1

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 373-6965 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6965

Date 12-4-2007

By _____


Zhengnian Tang
Reg. No: 55,666

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 4th day of December, 2007.

LATE GANON
Name

Karen G
Signature